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09/431,833	11/02/1999	JOSEPH PHILLIP BIGUS	IBM/02B	9272

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EXAMINER

COPPOLA, JACOB C

ART UNIT	PAPER NUMBER
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3621

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03/30/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/431,833	Applicant(s) BIGUS ET AL.	
	Examiner JACOB C. COPPOLA	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 54,56,57,59-61,104,105,107,109,110 and 112-116 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 54, 56, 57, 59-61, 104, 105, 107, 109, 110, and 112-116 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>21 November 2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. The USPTO Board of Patent Appeals and Interferences (“Board”) returned the undocked appeal to the Examiner on 1 March 2010. See “Order Returning Undocketed Appeal to Examiner” mailed 1 March 2010 (“March 2010 Board Return”). In the March 2010 Board Return, the Board ordered the Examiner to:

- 1) appropriately respond to the Amendment After Final dated February 16, 2009; and
- 2) for such further consideration as may be appropriate.

2. This action is in response to the March 2010 Board Return and Applicants’ reply with amendments filed on 16 February 2009 (“09 Feb Response”).

3. As noted in the March 2010 Board Return, Applicants filed a request for prosecution to be reopened by filing a reply under 37 C.F.R. §1.111 (with amendments) on 16 February 2009. Because the request complies with 37 C.F.R. §41.39(b)(1), the response is hereby entered and considered. Because Applicants have filed a request for prosecution to be reopened and because the Board returned this application to the Examiner, prosecution of this application is hereby reopened.

4. Claims 54, 56, 57, 59-61, 104, 105, 107, 109, 110, and 112-116 are currently pending and have been examined.

5. Unless expressly noted otherwise, all references in this Office Action (or in any future office action(s)) to the capitalized versions of “Applicant,” “Applicant(s),” or “Applicants” refer specifically to the Applicant of record. Conversely, references to lower case versions of “applicant,” “applicant(s)” or “applicants” refer not to the Applicant of record but to any one or

Art Unit: 3621

all patent applicant(s) generally. Unless expressly noted otherwise, references to the capitalized version of “Examiner” in this Office Action (or in any future office action(s)) refers specifically to the Examiner of record while reference to or use of the lower case version of “examiner,” “examiner(s),” or “examiners” refers to examiners generally.

6. This Office Action is given Paper No. 20100319. This Paper No. is for reference purposes only.

7. The Examiner of record has changed. Please indicate Jacob C. Coppola on any future correspondence. Contact information for Examiner Coppola may be found at the end of this Office action.

Divisional Application

8. This application is a divisional application of U.S. application no. 08/821,935 filed on 21 March 1997, now U.S. Patent 6,401,080 (“Parent Application”). See MPEP §201.06. In accordance with MPEP §609.02 *A. 2* and MPEP §2001.06(b) (last paragraph), the Examiner has reviewed and considered the prior art cited in the Parent Application. Also in accordance with MPEP §2001.06(b) (last paragraph), all documents cited or considered ‘of record’ in the Parent Application are now considered cited or ‘of record’ in this application. Additionally, Applicants are reminded that a listing of the information cited or ‘of record’ in the Parent Application need not be resubmitted in this application unless Applicants desire the information to be printed on a patent issuing from this application. See MPEP §609.02 *A. 2*.

Information Disclosure Statement

9. The Information Disclosure Statement filed on 21 November 2005 has been considered.
An initialed copy of the Form 1449 is enclosed herewith.

Claim Rejections - 35 USC §112, Second Paragraph

10. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 54, 56, 57, 59-61, 104, 105, 107, 109, 110, and 112-116 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claim 54 recites:

- 1 A method of identifying an unknown party interacting
2 with an intelligent agent, the method comprising, in a computer of the type including at
3 least one processor, executing a program to perform the steps of:
4 determining at least one attribute related to the unknown party, wherein
5 the unknown party is a party other than a client that has delegated at least one task
6 to the intelligent agent;
7 comparing the attribute for the unknown party with attributes related to
8 a plurality of known parties; and
9 identifying the unknown party as the known party having the attribute
10 which most closely matches that of the unknown party;
11 wherein the determining step determines a plurality of attributes related to the unknown
12 party, wherein the comparing step compares the plurality of attributes for the unknown
13 party with those of the plurality of known parties, wherein the unknown party is an
14 intelligent agent configured to conduct electronic transactions, and wherein the plurality of

Art Unit: 3621

15 attributes is selected from the group consisting of an agent name, a client name, a bank
16 name, a bank account number, a credit card number, a homebase location, an agent
17 program name, a location or name of a source with which the unknown party
18 communicates, and combinations thereof.

Regarding Claims 54, 60, 61, 113, and 114

12. Claim 54 recites “A method of identifying an unknown party interacting with an intelligent agent, the method comprising, in a computer of the type including at least one processor, executing a program to perform the steps of...” See ll. 1-3. The phrase “of the type” is indefinite because it is unclear what “type” Applicants are referring to.

13. Applicants appear to be limiting the method to a certain type of computer (*i.e.*, “a computer of the type including at least one processor”). Because all computers must have at least one processor, it is unclear as to which other types of computers may be referring to.

14. Claims 61, 113, and 114 recite similar limitations and are rejected for the same reasoning as directly above.

15. Claim 54 recites “determining at least one attribute related to the unknown party.” See l. 4. Claim 54 also recites “comparing *the attribute* for the unknown party...” (emphasis added) and “identifying... the known party having *the attribute*... of the unknown party...” (emphasis added). See ll. 7 & 9-10. Claim 54 is indefinite because, in the cases where two or more (*i.e.*, a plurality) attributes are determined in the determining step, one of ordinary skill in the art would not be able to determine to which of these attributes the phrase “the attribute” (of the comparing and identifying steps) is referring.

16. Claims 61, 113, and 114 recite similar limitations and are rejected for the same reasoning as directly above.

Art Unit: 3621

17. Claim 54 recites "... the known party having the attribute which most closely matches that of the unknown party...." See ll. 9-10. Claim 54 is indefinite because the phrase "most closely matches" as used in the context of claim 54 is subjective and lacks a definitive meaning.

18. Claims 60, 61, 113, and 114 recite similar limitations and are rejected for the same reasoning as directly above.

19. Claim 54 recites "determining at least one attribute related to the unknown party." See l. 4. Claim also 54 recites "wherein the determining step determines a plurality of attributes related to the unknown party." See ll. 11-12. In the particular case where only one attribute is determined in the determining step of line 4, the further limitation to the determining step, as described in lines 11-12, contradicts the results of determining only one attribute by requiring that a plurality of attributes now be determined.

20. Claims 60, 61, 113, and 114 recite similar limitations and are rejected for the same reasoning as directly above.

21. Claim 54 is indefinite because the scope of the claimed "intelligent agent" cannot be determined. How much intelligence does an agent have to possess to be considered intelligent? In discussing the importance of a computer program such as an "intelligent agent," Applicants elude to the existence of other types of computer programs. See 09 Feb Response at p. 9. What other types of programs either 'are' or 'are not' within the scope of claim 54? Are these other

Art Unit: 3621

programs non-intelligent agents, less intelligent agents, more intelligent agents, etc.? Guidance on intelligence is provided by Applicants on p. 3 of the specification:

Intelligent agents may also have differing capabilities in terms of intelligence, mobility, agency, and user interface. Intelligence is generally the amount of reasoning and decision making that an agent possesses. This intelligence can be as simple as following a predefined set of rules, or as complex as learning and adapting based upon a user's objectives and the agent's available resources.

From this one would understand that the intelligent agent varies in intelligence.

Nevertheless, is the claimed "intelligent agent" in possession of a certain amount of reasoning and decision making that makes it intelligent? Where is the line drawn in which an agent is determined to be non-intelligent?

22. Claims 60, 61, 113, and 114 recite similar limitations and are rejected for the same reasoning as directly above.

23. Claim 54 recites:

wherein the plurality of attributes is selected from the group consisting of an agent name, a client name, a bank name, a bank account number, a credit card number, a homebase location, an agent program name, a location or name of a source with which the unknown party communicates, and combinations thereof.

See ll. 14-18.

24. First, claim 54 is indefinite because the "selected" infers an additional action not recited as a method step (or functional instruction in the case of claim 60). It is unclear whether the method requires 'selecting a plurality of attributes' from which the "determining" step is made possible, or whether the "selected" is referring to the "determining" itself.

25. Second, claim 54 is indefinite because the meaning of the "group consisting of" is unclear in view of Applicants' remarks. The Federal Circuit has determined that the phrase

Art Unit: 3621

“group consisting of” is a closed term. See MPEP §2111.03. However, Applicants argue “It should also be noted that *given that the claims are open-ended, additional attributes beyond those enumerated in the claims* could also be compared in connection with identifying an unknown party.” See 09 Feb Response at p. 9.

26. Third, claim 54 requires the group to consist of several attributes and combinations thereof. However, the transitional phrase “consisting of” defines the scope of a claim with respect to what unrecited additional components or steps, if any, are excluded from the scope of the claim. See MPEP §2111.03. Accordingly the scope of claim 54 is defined to exclude all attributes unrecited in the list “an agent name, a client name, a bank name, a bank account number, a credit card number, a homebase location, an agent program name, a location or name of a source with which the unknown party communicates, and combinations thereof.” But the claim does allow for other scope definitions excluding attributes unrecited in “combinations thereof,” which will be subsets of the entire list. When the group is interpreted to be one of a “combinations thereof” (a subset of the listed attributes), then the scope of claim 54 is not defined to exclude all attributes unrecited in the list, rather it is now defined to exclude only the attributes of the subset combination. Therefore, claim 54 is indefinite because of the conflicting definitions of scope.

27. Claims 60, 61, 113, and 114 recite similar limitations and are rejected for the same reasoning as directly above (in the ¶¶ beginning with “First...,” “Second...,” and “Third...”).

28. Claim 60 recites “a database including a plurality of records, each record associated with a known party and including the plurality of attributes related thereto...” Claim 60 is indefinite

Art Unit: 3621

because it is unclear if each record has “attributes related thereto” or if only the plurality of records as a whole has “attributes related thereto.”

Claim Rejections - 35 USC §102

29. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

30. Claims 54, 56, 57, 59-61, 104, 105, 107, 109, 110, and 112-116, as understood by the Examiner, are rejected under 35 U.S.C. §102(e) as being anticipated by Stefik (U.S. 5,715,403 A).

Regarding Claims 54, 56, 57, 59-61, 104, 105, 107, 109, 110, and 112-116

31. Stefik discloses:

determining at least one attribute (“**1516~Access-Spec**”: fig. 15, determining shown in fig. 1) related to an unknown party (“Repository 2”: fig. 1), wherein the unknown party is a party other than a client that has delegated at least one task to the intelligent agent (no delegation involved between repositories);

Art Unit: 3621

comparing the attribute for the unknown party with attributes related to a plurality of known parties (repository 1 must know attributes of all authorized repositories – they will be listed in the rights for the digital work – fig. 15, also attribute 1516 relates to plurality of possible repositories); and

identifying the unknown party as the known party having the attribute which most closely matches that of the unknown party (if id of repository 2 found in list of authorized repositories matches, repository 2 can have digital work, “access granted” – fig. 1);

wherein the determining step determines a plurality of attributes related to the unknown party (plurality of attributes of fig. 15 which repository 2 may or may not have), wherein the comparing step compares the plurality of attributes for the unknown party with those of the plurality of known parties (repository 1 would check every attribute before granting access to repository 2 - fig. 1), wherein the unknown party is an intelligent agent (repositories are intelligent – see fig. 12) configured to conduct electronic transactions (see “credit server”), and wherein the plurality of attributes is selected from the group consisting of an agent name (1516 can be a name, see also c. 27), a client name, a bank name, a bank account number, a credit card number, a homebase location, an agent program name, a location or name of a source with which the unknown party communicates, and combinations thereof.

Claim Interpretation

32. The Examiner has determined that claims 60, 61, 104, 105, 107, 109, 110, and 112-116 are not patentably distinct from claims 54, 56, 57, and 59 (*i.e.*, claims 60, 61, 104, 105, 107, 109, 110, and 112-116 are of substantially the same subject matter as claims 54, 56, 57, and 59).

Art Unit: 3621

Accordingly, claims 60, 61, 104, 105, 107, 109, 110, and 112-116 are rejected in substantially the same manner as claims 54, 56, 57, and 59. If, in response to this action, Applicants disagree that the claims are not patentably distinct, and provide evidence that they are not of substantially the same subject matter, the Examiner may withdraw the rejection under §102 and alternatively impose a restriction requirement.

33. After careful review of the original specification, the Examiner is unable to locate any lexicographic definitions with the required clarity, deliberateness, and precision. See MPEP §2111.01 IV.

34. The Examiner finds that because the examined claims recite neither “step for” nor “means for,” the examined claims fail Prong (A) as set forth in MPEP §2181 I. Because the examined claims fail Prong (A) as set forth in MPEP §2181 I., the Examiner concludes that all examined claims do not invoke 35 U.S.C. §112, 6th paragraph. See also *Ex parte Miyazaki*, 89 USPQ2d 1207, 1215-16 (B.P.A.I. 2008)(precedential).

35. Regarding the conditional elements in the claims (*e.g.* claim 114 recites “controlling a behavior... when interacting with the unknown party...”), they too have been considered. However, Applicants are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See *e.g.* MPEP §2106 II C: “Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.” (emphasis in original).

Response to Arguments

36. Applicants' arguments with respect to the examined claims have been considered but are moot in view of the new grounds of rejection.

Conclusion

37. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure (see attached form PTO-892). All references listed on form PTO-892 are cited in their entirety.

38. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

39. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/
Patent Examiner, Art Unit 3621
March 19, 2010

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621